REMARKS

Claims 124-129 are pending in this application. The claims are not amended, however, pending claims are provided herewith for the convenience of the examiner. The Office Action is discussed below:

Withdrawal of the Enablement Rejection:

On page 2 of the office action, the examiner has withdrawn the rejection of claim 126 in response to the amendment filed on October 3, 2006. Applicants appreciate that the examiner has withdrawn the rejection.

Anticipation Rejection Maintained:

Applicants note that the examiner has changed the rejection of claims over Hyon *et al.* to read 35 U.S.C. 102(e), because its issue date of January 2, 2001 is after the filing date of the instant application.

On pages 2-3 of the office action, the examiner has maintained the alleged anticipation rejection and asserted that claims 127-129 do not specify the order of process of irradiating and heating steps. Applicants respectfully disagree with the examiner and point out that the claims 127-129 clearly recite step by step the process for preparing an orthopaedic implant prosthesis. According to the examiner, claims 127-129 when interpreted as claiming melting before irradiation are entitled to a filing date of 02-13-1996 and when interpreted as claiming irradiation before melting are entitled to a filing date of 10-02-1996. Accordingly, the examiner has maintained the alleged rejection of claims over Hyon *et al.* The examiner states that there are no Declarations under Rule 1.131 of record in the instant application.

Again, applicants respectfully disagree with the examiner and reiterate that Hyon has a section 102(e) date of May 6, 1996, which is after the earliest filing date of the instant application. Applicants note that, this application is a continuation of U.S. Serial

No. 10/197,209, which is a continuation of U.S. Serial No. 09/764,445. Apparently, the examiner could not find the data presented in the declaration filed on July 16, 2004 in the counterpart application serial No. 10/197,209, which are sufficient to support the invention of all the claimed process steps prior to May 6, 1996.

Applicants herewith provide a copy of the Rule 1.131 declaration that was filed on July 16, 2004 in the counterpart application (Serial No. 10/197,209) and show completion of the instant invention prior to the dates of Hyon patent. Accordingly, the Hyon patent is not prior art. Therefore, applicants submit that the rejection should be withdrawn. See *In re Spiller*, 500 F.2d 1170 (CCPA 1974); *In re Stempel*, 241 F.2d 755 (CCPA 1957).

On page 3 of the office action, the examiner has maintained the rejection and alleged that claims 124-129 are anticipated by Dijkstra *et al.* According to the examiner, the species of claims 127-129, wherein the UHMWPE preform is melted and then irradiated is disclosed by Dijkstra *et al.* The examiner believes that Dijkstra *et al.* disclose a process for crosslinking UHMWPE in the melt comprising heating a preform in a nitrogen atmosphere at 200°C with electron beams (refers to "experimental" on page 866, Table 1[sic]). The examiner agreed that Dijkstra *et al.* do not mention an orthopaedic implant prosthesis bearing, however, opined that the phrase "for preparing an orthopaedic implant prosthesis bearing...resistance" is a statement of future intended use that is not of patentable weight with respect to the claimed process steps. Again, applicants respectfully disagree with the examiner and reiterate that a method of making orthopaedic implant prosthesis bearing using heat treatment and subsequent irradiation or irradiation of UHMWPE is nowhere found in the Dijkstra *et al.* publication, and all of applicants' claim recitations breath life and meaning into the claims. See MPEP § 2111.02. Dijkstra discloses a process for making bar stocks of polyethylene and does not relate to a method for making an orthopaedic implant according to the claimed invention. Therefore, Dijkstra *et al.* publication is not relevant to the claimed invention.

Applicants also submit that the instantly claimed element "a method of making orthopaedic implant prosthesis bearing using heat treatment and subsequent irradiation or irradiation of UHMWPE" is not expressly or inherently disclosed in Dijkstra *et al.* Applicants refer the examiner to MPEP § 2131 (Rev. 5, August 2006) that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Accordingly, the Dijkstra *et al.* do not anticipate the claimed invention. Withdrawal of the rejection is therefore solicited.

Double Patenting Rejection:

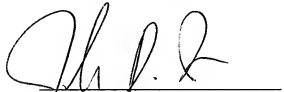
On pages 5-7 of the office action, the examiner has maintained the provisional rejection of the claims 124-127 under the judicially created doctrine of obviousness-type double patenting and alleged as being unpatentable over claims 124-129, 131-134, and claims 124-125, 130, 143-146 of co-pending application serial nos. 10/197,209 and 09/764,445, respectively.

Because none of the applications, '209 or '445, received a notice of allowance, applicants mention that the merits of this provisional rejection need not be discussed at this time. *See* MPEP § 822.01 (Rev. 5, August 2006).

REQUEST

Applicants submit that the claims 124-129 are in condition for allowance, and respectfully request favorable consideration to that effect. The examiner is invited to contact the undersigned at (202) 416-6800 should there be any questions.

Respectfully submitted,



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Date

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